REMARKS

Review and reconsiderations on the merits are requested.

At the time of rejection, claims 1-14 were pending.

Changes Made by Certificate of Correction

The changes I made in columns 139, 142 and 143 which were made by Certificate of Corrections. The changes occurred in claim 1 and claim 8.

It is believed that MPEP § 1411.01[R-2] has been followed, but if any additional material is necessary, the Examiner is requested to contact the undersigned at the later given local telephone exchange.

The Prior Art

U.S. 6,077,812 Crawford et al (Crawford); JP 9-315006 (JP '006); WO 97/29105 Miyazaki et al (Miyazaki); WO 97/08170 Crawford et al (WO '170); WO 97/09319 (WO '319).

Claim Rejections - 35 USC § 102

Claims 1, 4 and 7 were rejected as anticipated by Crawford.

Claims 1 and 7 were rejected as anticipated by JP '006.

Claims 1, 4 and 7 were rejected as anticipated by Miyazaki.

Claims 1, 4 and 7 were rejected as anticipated by WO '170.

The Examiner's reading and application of the prior art are set forth in the Action, and will not be repeated here except as necessary to an understanding of Applicants' traversal which is now presented.

Traversal

Applicants first would like to address the rejection of claims 1 and 7 as anticipated by JP '006.

The Examiner here specifically cites RN 201208-43-7.

Applicants respectfully submit that this compound is not disclosed in JP '006. The compounds of formula I in JP '006 are uracils substituted with R^2-O-. When R^2 is C_2H_5, the subsituent which binds to uracil is ethoxy. This compound is not within the scope of the claims 1 or 7 in the present application.

Also, according to the search results of CAPLUS attached with the Office Action, disclosure occurs as if JP '006 discloses "2,4(1H,3H)-Pyrimidinedione, 3-[2,4-bis(octyloxy)phenyl]-6-ethyl- (9CI) (CA INDEX NAME)". This error was pointed out to CAS, and the data were corrected to show that the compound disclosed in JP '006 was "2,4(1H,3H)-Pyrimidinedione, 3-[2,5-bis(octyloxy)phenyl]-6-ethoxy- (9CI) (CA INDEX NAME)".

Applicants believe they have avoided the rejection based on JP '006, given the above explanation, but as later indicated, request a telephone interview concerning this application.

With respect to the remaining novelty rejections based on RN 212755-11-8 in Crawford, based on structural formulae (A-1) and formula (A-2), with corresponding representative examples as set forth in Miyazaki and based on and the structural formula of the particular compound depicted in the Action from WO '170, Applicants amend the "proviso" clause by expanding the proviso to exclude "hydroxyl, alkynyloxy".

This was discussed with the Examiner during a short telephone interview, and the Examiner provisionally agreed that this avoided the rejection based on the fluoro compounds having the structural formulae given by the Examiner.

A telephone interview is requested concerning this issue.

Withdrawal is requested.

Claim Rejections -35 USC § 103

Claims 1, 2, 4, 7, 8 and 10-14 are rejected as obvious WO '319.

The Examiner's position is set forth in the Action in some detail, and will not be repeated here except as necessary to understand Applicants' traversal which is now presented.

Traversal

Applicants have reviewed WO '319, and advise that the closest compound in WO '319 to the rejected claims, in the view of Applicants, is Compound No. 2 in Table I on page 23 of WO '319.

Applicants submit herewith comparative data (Table 1) showing differences in herbicidal activity between the positioned isomers of the type relied upon by the Examiner.

Although the compounds disclosed in WO '319 are not precisely used, Applicants believe that the data and results established the patentability of the claims of the present application, as now explained.

Testing was carried out in the same manner as in Test Example (Pre-emerge Test) in the present specification. Compound No. 1-4 of the present invention, showed excellent herbicidal activity at a dose of 31 g/ha for key weeds in the upland field, i.e., *Amaranthus retroflexus*

(AMARE), *Sida spinose* (SIDSP) and *Abutilon theophrasti* (ABUTH), and also showed clear safety for corn. On the other hand, Comparative compound A showed weak activity for AMARE, and had no activity for other weeds.

The general rule that position isomers are *prima facie* obvious is predicated upon the assumption that position isomers will generally exhibit similar properties. Applicants respectfully submit that the results between Compound No. 1-4 and Comparative Compound A show that the assumption in this case is not correct, i.e., here the position isomers do not exhibit expected results, rather, the position isomer of the present invention provides unexpectedly superior results.

With respect to the results with Position isomer of Comparative Compound B versus the results obtained with Comparative Compound B, the same general tendency in herbicidal activity is seen.

Thus, Applicants respectfully submit that the data in the attached DECLARATION rebuts the presumption regarding position isomers, which presumption is necessary for a finding of *prima facie* obviousness.

Applicants have reviewed WO '319 and they advise that WO '319 predicts herbicidal effects at pages 26-27, but no herbicidal test results are given. Further, according to the test results in the attached DECLARATION, it is submitted that the test results establish that compounds having an amino group at the 3-position do not have excellent herbicidal activity. Accordingly, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to prepare the compounds of the present invention based on WO '319.

In distinction to the situation with the compounds of WO '319, the compounds of the present invention are characterized in that a substituent such that a substituted amino group is introduced into the position of Z in formula (I). As a consequence, the compounds of the present invention exhibit excellent herbicidal activity, as discussed in detail in the present specification.

In short, Applicants believe they have removed an essential predicate to the rejection over WO '319, i.e., the expectation of one ordinary skill in the art that position isomers would exhibit similar properties.

Withdrawal of the rejection over WO '319 is requested.

Allowance is requested.

With respect to Crawford '812, Applicants have stated: Upon a review of Crawford '812, Applicants found that "1-methyl-6-trifluoromethyl-3-(4-bromo-2-fluoro-5-hydroxy-6-nitrophenyl)-2,4(1H,3H)-pyrimidinedion" is described at column 9, lines 64-65 and "1-methyl-6-trifluoromethyl-3-(4-chloro-2-fluoro-5-hydroxy-6-nitrophenyl)2,4(1H,3H)-pyrimidinedion" is described at column 11, lines 41-42. These compounds are within the scope of claim 9 of the present application.

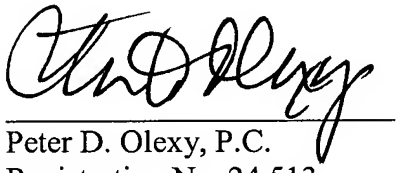
A telephone interview is requested regarding this proviso clause if the Examiner finds it unacceptable.

Considering the above, Applicants have added the proviso clause to claim 9 to avoid the two compounds in Crawford '812 having a nitro group at the 6-position of the benzene ring.

A telephone interview is requested regarding this proviso clause if the Examiner finds it unacceptable.

Several minor typographical errors in the claims are corrected. An executed copy of the DECLARATION will shortly be submitted.

Respectfully submitted,



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